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Paper No. 17
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cytokinetics, Inc.

Serial No. 75/557,383

James E. Austin of Beyer Weaver & Thomas, LLP for
Cytokinetics, Inc.

John M. Gartner, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before Hohein, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Cytokinetics, Inc. has filed an application to
register on the Principal Register the mark CYTOKINETICS
for the following services, as amended: "consultation and
research services relating to drug discovery and
development and patient diagnosis" in International Class
42.¹

¹ Application Serial No. 75/557,383, filed September 23, 1998,
based on applicant's assertion of a bona fide intention to use
the mark in commerce.

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that when used in connection with applicant's services, the term CYTOKINETICS is merely descriptive of them.

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Applicant explains its business and the science involved in its business as follows (citations to exhibits omitted):

Cytokinetics, Inc.'s research and drug development efforts target proteins that make up the cytoskeleton. Such proteins are involved in various diseases; therefore, Cytokinetics, Inc. seeks to develop new therapies for cancer, cardiovascular diseases, and infectious diseases by focusing on cytoskeletal proteins.

The cytoskeleton of a cell is made up of [a] network of protein filaments. The cytoskeleton 'plays a fundamental role in all aspects of cell mechanics, including cell division, intracellular transport, cell motility and the establishment and regulation of cell polarity and organization.'

Cell division in multi-celled organisms occurs when 1) the cell nucleus divides, a process known as mitosis; and 2) the cytoplasm of the cell splits in two, a process known as cytokinesis. (Brief, pp. 3-4)

Applicant contends that the term CYTOKINETICS is a coined term identifying applicant; that the prefix "cyto" suggests a relationship to cells, and the suffix "kinetics" suggests movement; that the combination CYTOKINETICS could suggest any one of many different meanings depending on the context in which it is used (for example, in cell biology and physiology it might refer to "the movement of organelles inside the cell or to different aspects of cell motility," while in pharmacology it might refer to "the dynamics of cellular population changes or to effects on cellular populations mediated by hormones called cytokines," brief, p. 6); that the term does not directly and immediately convey any precise significance or information about applicant's services; that there is no evidence that the term CYTOKINETICS directly equates to the study of the cytoskeleton² or cytoskeleton proteins; and

² Pursuant to TBMP §712 and the rules and cases cited therein, we take judicial notice of the definition of "cytoskeleton" set forth in The Random House Dictionary of the English Language (Unabridged) (2nd ed. 1987):

"n. Cell Biol. A shifting lattice arrangement of structural and contractile components distributed throughout the cell cytoplasm, composed of microtubules, microfilaments, and larger filaments, functioning as a structural support and transport mechanism. [cyto- + -skeleton] - cytoskeletal adj."

that there is no evidence that competitors use or need to use the term CYTOKINETICS to describe similar services.

As evidence in support of its position, applicant submitted the declaration of David Drubin, Ph.D, a professor of genetics at the University of California, Berkeley, and a member of applicant's Advisory Board; a copy of a page from a 1992 dictionary showing the term "cytokinesis," without reference to the adjective "cytokinetic"; and (with its main brief), on-line dictionary definitions of the terms "cyto" and "kinetics."³ In addition, applicant had submitted, in response to the Examining Attorney's request for information, a packet of information regarding applicant and the services it intends to offer under the term CYTOKINETICS.

The Examining Attorney contends that the term "CYTOKINETICS" is not a coined term, but rather is a dictionary term used to refer to the division of the cytoplasm of a cell following the division of the nucleus; that the term is widely used by scientists and describes "cell behavior, most especially in the area of cancer

³ The Examining Attorney objected to the later-filed dictionary definitions as being untimely under Trademark Rule 2.142(d). However, the on-line dictionary involved is the American Heritage Dictionary of the English Language (3rd ed. 1996). Inasmuch as we find it appropriate to take judicial notice of definitions from this dictionary, the Examining Attorney's objection is overruled.

research" (Final Office action, p. 2); and that the term is merely descriptive of applicant's consultation and research services relating to drug development and patient diagnosis involving research in the area of cell division or cell behavior.

As evidence in support of the refusal to register, the Examining Attorney relies on the dictionary definition which he submitted of the term "cytokinesis"; over 50 excerpted stories from the Nexis database which include uses of the term "cytokinesis" or "cytokinetic(s)"; and pages printed from several different websites which include uses of the term "cytokinetics."

In the on-line American Heritage Dictionary of the English Language (3rd ed. 1992⁴) submitted by the Examining Attorney, the term "cytokinesis" is defined as follows:

"noun The division of the cytoplasm of a cell following the division of the nucleus. -cytokinetic adjective."

In addition, we take judicial notice of the following definition of "cytokinesis" from The Random House Dictionary of the English Language (Unabridged) (2nd ed. 1987):

⁴ For reasons unknown to the Board the two on-line American Heritage dictionaries referred to in footnote 3 and above carry two different dates, 1992 and 1996.

"n. Cell Biol. The division of the cell cytoplasm that usually follows mitotic or meiotic division of the nucleus [1915-20; cyto- + -kinesis] - cytokinetic adj."

Several representative examples from the excerpted Nexis stories showing use of the term "cytokinetic(s)," especially in relation to drug research and development, are reproduced below (emphasis added):

Title: Prognostic significance of pretreatment proliferative activity in adult acute leukemia
...Once in complete remission, an initially high labeling index was an unfavorable sign with respect to length of remission, regardless of the patient's diagnosis. The results of this study are supportive of studies in experimental systems demonstrating the importance of **cytokinetic** factors in the administration of chemotherapy and suggest that such factors may be of clinical importance in selecting approaches to therapy. "EMBASE (The Excerpta Medica Database)" 1977;

Headline: Primed for Growth
Remicade was approved for marketing by the U.S. Food and Drug Administration Aug. 24, 1998. Previously, the drug was known as Avakine. The name, however, was changed at the request of the Food and Drug Administration. The regulatory agency prefers to reserve the suffix 'kine' for products that involve **cytokinetic** therapy. "Med Ad News," November 1998;

Title: Effect of Flavone Acetic Acid on Lewis Lung Carcinoma: Evidence for an Indirect Effect

...FAA is highly active against a slowly growing variant of the LL carcinoma, which has different **cytokinetics** from the original in vivo tumor and which has developed resistance to two drugs. "Journal of the National Cancer Institute," April 20, 1998;

Title: Phase I Study of Continuous Venous Infusion of Floxuridine (5-FUDR) Chemotherapy
The continuous-infusion schedule for delivery of cancer chemotherapy has theoretic advantages based on considerations of drug pharmacology and tumor cell **cytokinetics**. ..., "Cancer Treatment Reports," September 1983;

Title: Unresolved Issues in Combination Chemotherapy
...The point is that a postulated mechanism of interaction between two or more drugs - whether the interaction is on a biochemical, pharmacokinetic, or **cytokinetic** basis - may obviously be valid motivation for a clinical trial. In fact, these kinds of hypothesis-based trials may be our best hope for further improvements in combination chemotherapy using the available drugs. "Cancer Treatment Reports," January 1986;

Title: Cyclophosphamide/Etoposide: Effective Reduction Therapy for Children with Acute Nonlymphocytic Leukemia in Relapse
...in a study designated AML-80, which included constant-infusion cytarabine (ara-C), maximal doses of anthracyclines, and VP-16/5-Az, and one in an earlier clinical trial that featured **cytokinetic-based** therapy. "Cancer Treatment Reports," July/August 1985;

Title: Arterial Drug Infusion With Extracorporeal Removal
...administration of a drug, both tumor and sensitive normal tissues are perfused by arterial blood at the same concentration so that a pharmacokinetic advantage would not normally be obtained, and any selectivity would depend on biochemical or **cytokinetic** factors. "Cancer Treatment Reports," February 1984;

Title: Circadian cell kinetics in humans. Aspects related to cancer chemotherapy
...cell kinetics, has been the development from the 1950s and onwards of several methods for studying kinetic parameters in different mammalian tissues. ... Results from **cytokinetic** studies in the human have also accumulated through the years. ... Thus, these studies have demonstrated that there exist rhythms in bone marrow and gut cytokinetics which increases the likelihood that certain times of day will be less toxic for the administration of cytotoxic drugs. "National Library of Medicine Medline Database," "Cite: In Vivo Nov/Dec 1995";

Headline: Screening mammography and public health policy; the need for perspective
...In view of what we know about the **cytokinetics** of the disease, we should not be surprised that the eventual outcome (death due to breast cancer) for the large majority of women is unaffected by screening mammography. "The Lancet," July 1, 1995;

Title: Curative chemotherapy for acute myeloid leukemia: the development of high-dose ara-C from the laboratory to the bedside

...The clinical development of ara-C for the treatment of acute myeloid leukemia (AML) provides a useful paradigm for the study of this process. An understanding of the cellular pharmacology, **cytokinetics** and pharmacokinetics of ara-C in leukemic mice showed substantial schedule-dependency. "National Library of Medicine Medline Database," "Cite: Invest New Drugs 1996";

Title: Strategies in the treatment of acute myelogenous leukemia
...Prognostic factors which predict for outcome include phenotyping, cytogenetics, **cytokinetics**, drug resistance and age. ..., "National Library of Medicine Medline Database," "Cite: Leuk Res 1992";

Title: **Cytokinetics** and chemotherapy of psoriasis
The successful treatment of psoriasis with folic acid antagonists during the past 25 years has led to extensive research in the areas of **cytokinetics** and chemotherapy. ..., "National Library of Medicine Medline Database," "Cite: J Invest Dermatol 1976"; and

Title: Phase I Trial of Cytarabine and Hydroxyurea
<4> Reprint request to: Dr. Stephen B. Howell, Laboratory of Pharmacology and **Cytokinetics**, University of California at San Diego Cancer Center, ..., "Cancer Treatment Reports," December 1983.

Two examples of the pages printed from a few different websites include the following uses of "cytokinetics" (bold emphasis added):

- (1) Adel K. El-Naggar, M.D., Ph.D.
Chief, Section of **Cytokinetics** and Service Flow
Cytometry
Research Interests: Flow cytometry, Molecular and
genetic markers in cancer, Head and neck
neoplasia, Translation molecular biology
...
Department of Pathology
The University of Texas M.D. Anderson Cancer
Center
<http://utmdacc.uth.tmc.edu>; and
- (2) The International Union Against Cancer
International Directory of Cancer Institutes and
Organisations
City of Hope National Medical Center
...
Experimental cancer research: Differentiation;
Cytokinetics; Experimental Pathology;
Pharmacology; Drug Resistance; Molecular Cloning;
Enzymology, Liposomes; Marrow
Transplantation;....,
<http://www.globalink.org/directory/uschnmc.html>.

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is or will be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made in relation to the goods or services for which registration is

sought, the context in which the term is being or will be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). That is, the question is not whether someone presented with only the mark could guess what the goods or services are.

Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In light of the dictionary definitions showing that "cytokinetic" is the adjectival form of the noun "cytokinesis," applicant's argument that the term "cytokinetics" is a "coined" term is unpersuasive. Given that the dictionaries were published well prior to applicant's founding in 1998, it is implausible that the term was "coined" by applicant. To the extent applicant argues, without having clearly made such an argument, to the effect that the addition of the letter "s" makes it a "coined" term, we simply disagree. The term is merely descriptive of consultation and research services relating

to drug discovery and development and patient diagnosis which are based on studies of, inter alia, cytokinetic activity in cells.

Moreover, applicant's services are broadly described as involving "research services relating to drug discovery and development and patient diagnosis," and "cytokinetic" research or study is encompassed within this broad description of applicant's research services. Even if applicant limits its activities to research concerning the cytoskeleton, it is clear that applicant conducts drug research centered around cell biology, which includes cytokinesis. Applicant submitted a paper titled "17 Cell Division," in which one of the subheadings is "The Cytoskeleton Carries Out Both Mitosis and Cytokinesis."

Even if, as argued by applicant, the term "cytokinetics" may have different meanings in different specific scientific fields of study, there is ample evidence of record to show that the term is merely descriptive of applicant's identified services.⁵ In addition to the dictionary definitions, the Nexis stories and the website printouts which establish that applicant's

⁵ We are not convinced otherwise by the declaration submitted by applicant of David Drubin, Ph.D., a professor of genetics. We note particularly that he is a member of applicant's Advisory Board, and thus there is a self-serving aspect to his declaration which cannot be ignored.

mark is merely descriptive, there is also applicant's own informational submission, which clearly relates applicant's research services to cell division, including cytokinesis.

The following are quotes from articles submitted by applicant (bold emphasis added):

Sabry [James Sabry, applicant's president and chief executive officer] said Cytokinetics is the first and only company focused on the cytoskeleton, which is the multi-component framework involved in **all aspects of cell mechanics, including cell division**, motility, transport and regulation of cell polarity and organization. This will lead to novel drug targets, drug classes and mechanisms of action, Sabry told BioWorld Today. ... The company's initial focus will be in the areas of cancer, infectious diseases and cardiovascular disease, with a first partnership expected in 1999. "New Firm Focuses on Cytoskeleton Research," BioWorld Today, December 31, 1998; and

Cytokinetics Inc. is focused on the cytoskeleton—which is comprised of the structures of the cell involved in the dynamic 'urban design' of cellular function and mechanics, including **cell division**, intracellular transport, cell motility and the establishment and regulation of cell polarity. "Cytokinetics: The cell is a city," BioCentury, December 21, 1998.

We agree with the Examining Attorney that the applied-for mark CYTOKINETICS immediately and directly conveys information about a significant feature or aspect of

applicant's "consultation and research services relating to drug discovery and development and patient diagnosis"; specifically, that a significant aspect of applicant's services is conducting research in the field of drug discovery and development involving the study of all cell mechanics including cell division. Clearly, applicant's services (as identified) are associated with cytokinetic study. The users and purchasers of applicant's services, who would include such highly educated and sophisticated individuals as doctors and scientists, would undoubtedly understand that applicant's mark, if and when used in connection with the identified services, relates to cytokinetic research services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Finally, even if applicant became the first entity to use the term "CYTOKINETICS" in relation to "consultation and research services relating to drug discovery and development and patient diagnosis," such is not dispositive where, as here, the term unquestionably projects a merely descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d

1949, 1953 (TTAB 1994), and cases cited therein. We believe competitors would have a competitive need to use this term. In this regard we particularly note the evidence of use of the term "Cytokinetics" as part of the name of a section of a department at the University of Texas and as part of the name of a laboratory at the University of California at San Diego. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

Decision: The refusal to register under Section 2(e)(1) is affirmed.